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Serial No.: 09/815,628

- 6 -

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REMARKS

In an Office Action mailed August 1, 2002, the Examiner objected to the section headings, and rejected claims 9, 10, 15, and 17. By the present amendment, the section headings have been amended in accordance with the Examiner's objection. In addition, claims 1-3, 9-14, and 22-24 have been cancelled. Claims 17-21 are reproduced herein, without amendment, for ease of reference. Claims 4-8, 15, and 16 have been amended so as to depend from independent claim 17, the only independent claim remaining in the application. New claim 25, which also depends from independent claim 17, has been added.

Claim 17 stood rejected under 35 U.S.C. §103 over the combination of U.S. Patent No. 5,396,739 to Venegas and U.S. Patent No. 4,053,140 to Clemens. Claim 17 is submitted herein, without amendment, for reconsideration in light of the following remarks.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembicza, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

These holdings are directly applicable to the present case. While the Venegas case shows a guardrail assembly with polymerized sheathing, there is no teaching whatsoever as to providing vertical posts and upper and lower rails that are releasably engaged with one another. Also, Venegas fails to

show polymerized sheathing that is removable and replaceable. The configuration of the guardrail in Venegas prevents removal of the polymerized sheathing. Likewise, while the Clemens reference shows the use of structural fittings to removably interconnect various members, there is no teaching whatsoever as to the provision of posts and rails with removable and replaceable polymerized sheathing or the provision of an infill panel. It should be noted that the Clemens patent is directed to fiber reinforced plastic handrails, rather than rails that are covered with a plastic sheathing. Because there is no teaching or suggestion in either of the cited references that would lead one of skill in the art to combine the two references, the only motivation or teaching could only come from Applicant's own disclosure, resulting in an inappropriate rejection based on hindsight.

Applicant's invention provides a combination of elements not provided in any single piece of prior art, and not provided by an obvious combination of prior art. The provision of removable and replaceable polymerized sheathing allows semi-custom color choice and change of color of a handrail assembly according to the present invention. Also, the infill panel provides a function not provided by the prior art and an aesthetic appearance not provided by the prior art.

Even if the Venegas and Clemens devices were to be combined, it is unclear what would result. Clemens merely provides a plastic handrail, while Venegas provides a bent plastic sheathed metal rail with an infill panel attached to the metal portion of the rail. Consequently, the infill panel cannot be easily added to Clemens, and the Clemens' fittings cannot be applied to Venegas. Applicant submits that, just because it would be possible to somehow cherry-pick various elements from various pieces of prior art and combine them in accordance with the teaching of the present invention, the present invention is not merely an obvious combination of prior art elements.

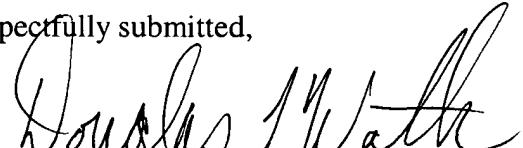
In light of the above, Applicant respectfully submits that claim 17 is in condition for allowance.

All other claims presented herein depend from claim 17 and are therefore are also in condition for allowance. Additionally, the various dependent claims provide additional limitations that are neither taught nor suggested by the prior art. As one example, new claim 25 provides that the rails and posts are all substantially straight members and the sheathing is substantially straight. This further clarifies a distinction between the present invention and the Venegas reference. As another example, claim 6 provides a specific construction of the interconnection between the infill panel and the hand rail.

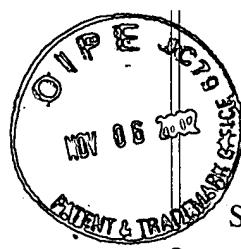
In light of the above, Applicant respectfully submits that all claims are now in condition for allowance, and favorable action is hereby requested. Any questions should be directed to Applicant's below-signed representative.

Respectfully submitted,

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Date: November 1, 2002

VERSION WITH MARKINGS TO SHOW CHANGES MADEIN THE ABSTRACT

Please replace the section heading on page 28, line 1, with the following:

ABSTRACTIN THE SPECIFICATION

Please replace the section heading on page 1, line 1, with the following:

REFERENCE TO RELATED APPLICATION

Please replace the section heading on page 1, line 7, with the following:

FIELD OF THE INVENTION

Please replace the section heading on page 1, line 11, with the following:

BACKGROUND OF THE INVENTION

Please replace the section heading on page 3, line 8, with the following:

SUMMARY OF THE INVENTION

Please replace the section heading on page 5, line 1, with the following:

BRIEF DESCRIPTION OF THE DRAWINGS

Please replace the section headings on page 6, line 19, with the following:

DETAILED DESCRIPTION OF THE INVENTIONIN THE CLAIMS

4. (Amended) The hand rail [system] assembly as defined in claim [1] 17, further comprising:

a third vertical post, the [horizontal] rails being removably engaged with the third vertical post;

and

removable and replaceable polymerized sheathing surrounding the third vertical post, the sheathing having an interior diameter equal to or greater than the outer diameter of the vertical post and extending the height of the post.

5. (Amended) The hand rail [system] assembly as defined in claim [1] 17, wherein the [spaced-apart vertical posts and the spaced-apart horizontal rails define a framed area, the system further including an] infill panel [having] has an area which substantially consumes the framed area; the panel being mounted in the framed area.

6. (Amended) The hand rail [system] assembly as defined in claim 5, further comprising one or more sections of U-channel affixed to each of the vertical posts and the [horizontal] rails for mounting the infill panel.

7. (Amended) The hand rail [system] assembly as defined in claim 5, wherein the infill panel is a mesh screen.

8. (Amended) The hand rail [system] assembly as defined in claim 5, wherein the infill panel is a solid panel.

15. (Amended) The hand rail assembly according to claim [10] 17, further comprising structural fittings interconnecting the rails with the posts, at least one of the structural fittings

comprising a slip-on fitting having an inner diameter greater than or equal to the outer diameter of the plastic sheathing on the posts or rails.

16. (Amended) The hand rail assembly according to claim 15, wherein the structural fitting further comprises a set screw operable to press against the plastic sheathing such that the fitting grips the sheathing and the post or rail without penetrating the sheathing.